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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,493	07/08/2003	Nancy Rapp	118443-1005	8973
32914	7590	03/27/2007	EXAMINER	
GARDERE WYNNE SEWELL LLP INTELLECTUAL PROPERTY SECTION 3000 THANKSGIVING TOWER 1601 ELM ST DALLAS, TX 75201-4761			SUHOL, DMITRY	
		ART UNIT	PAPER NUMBER	
				3725
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/27/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/615,493	RAPP ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Dmitry Suhol	3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 29 December 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 37,38 and 40-75 is/are pending in the application.
  - 4a) Of the above claim(s) 60,61 and 63-75 is/are withdrawn from consideration.
- 5) Claim(s) 37,38,40-56 and 62 is/are allowed.
- 6) Claim(s) 57-59 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ .  | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application contains claims 60-61 and 63-75 drawn to an invention nonelected with traverse in Paper dated 2/14/2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Priority***

Applicants list claim to a provisional application 60/394397 in the Oath/Declaration, however in the first line of the specification applicants request priority to provisional 60/394367. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 57-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benefiel '732. Benefiel discloses a process for the manufacture of a rolled substrate

containing all of the claimed elements including, a substrate having a first and second surface (115), disposing a first and second material on the first surface and a third material on the second surface is disclosed as the application of a thermo-setting primer coating which is applied to both sides of the sheet (see column 4, lines 33 to 35) after which a pigmented base coating and clear topcoat are applied to one surface. See column 4, lines 39 to 41 and 53 to 55. The materials of the coatings may be polyesters and fluoropolymers (see column 6, lines 60 to 63) which are known materials to have "reflective" properties as pointed to by the applicants in their disclosure. Benefiel advises that the process results in stock material having an excellent painted glossy appearance. See column 8, lines 20 and 21. Therefore recitation in these claims of coating with a reflective material does not distinguish over the coating having an excellent painted appearance, as disclosed by Benefiel. It should be noted that the unrolling and forming the substrate into individual characters for signs is not positively claimed and therefore does not serve to patentably distinguish.

Regarding the single step process of applying the first and second materials as claimed, Official notice is taken that disposing first and second coating materials in a single step is a well known expedient in the coating art, and to apply the coating material of Benefiel in such a manner would be merely an obvious utilization of conventional knowledge present in the art for the purpose of production efficiencies and costs.

Regarding the limitations of claim 59, Benefiel discloses thicknesses of 0.1 mils to 2.5 mils to be sufficient for a pigmented coating. See column 4, lines 49 to 51. Thus,

the limitation in Claim 59 that the thickness of the materials is less than 1.4 mils is considered to be merely an obvious exercise of designer's choice in the utilization of knowledge clearly available in the art to optimize results for the intended use of the product, and not a patentable distinction absent a disclosure of criticality in the solution of stated problems with the provision any specific combination of material thicknesses.

***Allowable Subject Matter***

Claims 37-38, 40-56 and 62 are allowed.

***Response to Arguments***

Applicant's arguments filed 12/29/2006 have been fully considered but they are not persuasive. Applicants argue that Benefil fails to teach all of the claimed limitations, specifically the formation of channel letters for a sign having an increased reflectivity. In response the examiner points out that claim 57 does not positively claim the formation step but rather recites such limitations in a functional sense in which case the substrate of Benefil is capable of fulfilling such function.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-272-4430. The examiner can normally be reached on Mon - Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Dmitry Suhol

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Primary Examiner  
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